

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

10/069,932

Examiner

Katherine M. Moran

Applicant(s)

KOBAYASHI, TOYOHIRO

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 18 November 2004 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
- ☒ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☒ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

- ★ 1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.



## Revised Amendment Practice After Final Amendments

- ✧ For example, if some of the status identifiers are incorrect in the after-final amendment, examiner may:
  1. Provide a claim listing presenting all of the claims with the proper status identifiers in an examiner's amendment;
  2. Print a copy of the claim listing of the non-compliant after final amendment, cross out the improper status identifiers, write in the correct status identifiers and include it as an attachment to an examiner's amendment; or
  3. Correct the improper status identifiers by instructions in an examiner's amendment.

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## Revised Amendment Practice After Final Amendments

- ✧ Examiners are responsible for determining whether after-final amendments are in compliance with 37 CFR 1.121.
- ✧ If the amendment is non-compliant, the examiner should notify applicant and provide the reasons for the non-compliance.
- ✧ The examiner may use the Notice of Non-Compliance Amendment with an advisory action to notify the applicant.
- ✧ The time period continues to run and no new time period will be provided in the advisory action for non-compliant after-final amendments.

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## Revised Amendment Practice After Final Amendments

- ✧ A non-compliant after final amendment may be corrected by using an examiner's amendment.
  1. Within six-month statutory period: examiner may correct the non-compliance and any other substantive omissions to place the application in condition for allowance.
    - Applicant's authorization for the examiner's amendment is required to be provided within the statutory period and any required extension of time fee is paid.
  2. After the six-month statutory period: examiner may correct the non-compliance if the examiner's amendment is limited to correcting format errors (such as correcting the status identifiers).

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## Revised Amendment Practice *Non-compliant Amendment*

- ✘ If the amendment is a reply to a non-final Office action, technical support staff will mail applicant a Notice of Non-Compliant Amendment that identifies:
  - Each section of the amendment that is not in compliance with 37 CFR 1.121;
  - Items that are required for compliance; and
  - The reasons why the section of the amendment fails to comply with 37 CFR 1.121.
- ✘ In reply to the Notice, applicants must submit the corrected section of the amendment that was non-compliant.
  - Re-submission of the entire amendment is not required.
  - The entire section, however, with corrections, must be resubmitted.

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## Revised Amendment Practice *After Final Amendments*

- ✘ Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment.
  - Markings to show changes relative to any unentered amendment are not permitted.

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## Revised Amendment Practice *Amendments to Specification*

- ✧ The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.
  - The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.
- ✧ Do not underline the text of a new paragraph or section.
- ✧ Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.
- ✧ Replacement paragraph or section must be a marked-up version showing the changes.
- ✧ A clean version of any replacement paragraph or section must not be submitted in addition to a marked-up version, except when applicant submits a substitute specification.

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## Revised Amendment Practice *Amendments to Abstract*

- ✧ An amendment to an abstract is treated like an amendment to the specification.
  - If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.
  - If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.
  - Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

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